

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Bhat, *et al.*

Serial No.: 09/267,199

Filed: March 12, 1999

For: Nucleic Acid Molecules and Other  
Molecules Associated with the  
Tocopherol Pathway

Docket No.: 04983.0024.00US01  
38-21(15092)B

Group Art Unit: 1631

Examiner: M. Moran

#6  
P/UnKeta  
9/18/00

**Response to Restriction Requirement**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In the Office Action mailed August 14, 2000, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claims 1-2, drawn to a substantially purified nucleic acid encoding a maize or a soybean protein, classified in class 536, subclass 23.1;

Group II: Claims 3-4, drawn to a substantially purified maize or soybean tocopherol synthesis pathway enzyme, classified in class 530, subclass 300.

Group III: Claim 5, drawn to an isolated antibody that binds the polypeptide, classified in class 530, subclass 387.9.

Group IV: Claims 6-7, drawn to a transformed plant comprising a promoter, a structural nucleic acid molecule encoding a maize or soybean tocopherol synthesis pathway enzyme, and a non-translated 3' sequence, classified in class 800, subclass 205.

Group V: Claims 8-9, drawn to a method for determining the level or pattern in a plant cell of a tocopherol synthesis pathway enzyme, classified in class 435, subclass 15.

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Bhat, *et al.*  
Application No. 09/267,199

Applicants respectfully traverse the restriction requirement, and provisionally elect the claims of Group I (claims 1-2) for further prosecution.

Applicants submit that the complete examination of the application would be most expeditiously handled by treating all of the pending claims as a single entity. As Section 803 of the MPEP states, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." It is respectfully submitted that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. No serious burden is created when a simultaneous computerized search for the nucleic acids of Group I and the nucleic acids used in the methods of Group V is run, for example. A single search may be run, for example, in conjunction with databases such as those available at <http://www.ncbi.nlm.nih>. Rather, a serious burden would arise if the application were restricted.

Based on the foregoing, Applicants submit that the restriction requirement is improper and therefore must be withdrawn. To facilitate prosecution, however, Applicants have provisionally elected, with traverse, Group I (claims 1-2).

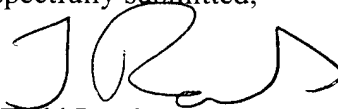
The Office Action further requires that no more than 10 specific sequences may be specified for examination. In view of Applicants' provisional election of Group I, and in the event that the restriction requirement is made final, it is hereby requested that SEQ ID NOS: 1, 100, 147, 153, 158, 161, 180, 184, 199, and 232 be examined in this application:

However, the election of the above sequences is made with traverse. The Examiner's restriction to 10 sequences is improper. Examination of more than 10 sequences for the polynucleotides of claims 1 and 2 would not present an undue burden due to interrelationship between the disclosed sequences.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicant's undersigned representative at (202) 383-6799.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 08-3038.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'J Rands', written over the typed name of M. Todd Rands.

M. Todd Rands (Reg. No. 46,249)  
David R. Marsh (Reg. No. 41,408)  
June E. Cohan (Reg. No. 43,741)

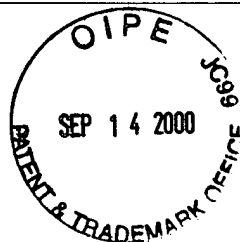
Date: September 14, 2000

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September 14, 2000

Assistant Commissioner for Patents  
Washington, DC 20231

Re: U.S. Utility Application No. 09/267,199  
Filed: March 12, 1999; Group Art Unit: 1631  
For: Nucleic Acid Molecules and Other Molecules  
Associated with the Tocopherol Pathway  
Inventors: Barkur G. BHAT *et al.*  
Atty. Docket: 04983.0024.00US01/38-21(15092)B

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (PTO) are the following documents:

1. Response to Restriction Requirement; and
2. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 08-3038. A duplicate copy of this letter is enclosed.

Sincerely,

A handwritten signature in black ink, appearing to be "M. Todd Rands".

M. Todd Rands (Reg. No. 46,249)  
David R. Marsh (Reg. No. 41,408)  
June E. Cohan (Reg. No. 43,741)

Enclosures